

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : THEOBALD et al.
Serial No. : 10/567,077 (U.S. Publication No: 2006-0210615)
Filing Date : 3 February 2006
For : DERMAL OR TRANSDERMAL THERAPEUTIC SYSTEM
COMPRISING AN ORMOCER WITH BARRIER EFFECT ON A
COVER FOIL
Examiner : WESTERBERG, Nissa
Art Unit : 1618

745 Fifth Avenue
New York, NY 10151

PETITION OF FINALITY OF RESTRICTION REQUIREMENT

Mail Stop: **Petitions (Group Director 1610 – George Elliott)**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Please accept this petition against the holding of finality of the restriction and election of species requirement from the Office Action dated 28 May 2008.

ACTION REQUESTED

The applicants request withdrawal of the finality of the lack of unity of invention which was made by the Examiner in the Restriction Requirement of 20 February 2008 and that the subject matter represented by original claim 7 be examined on the merits.

STATEMENT OF FACTS

A Restriction Requirement was mailed to the applicants which sought to restrict the applicants' claims because the claims allegedly lacked unity of invention and therefore two election of species requirements were made.

- (1) Election if the supporting layer of a covering film is or is not comprised of at least one organic polymer.
- (2) Election if the at least one ormocer layer is applied on both surfaces of the supporting layer or if the ormocer layer is not applied on both surfaces of the supporting layer.

The applicants filed a response with traverse on 3 April 2008 which elected the situation where the supporting layer is composed of at least one organic polymer layer for the first election requirement and the situation where the at least one ormocer layer is applied on both sides of the supporting layer (see claim 8).

The applicants' traversal stated that "the PCT upon which this application is based was NOT subjected to an election of species requirement, i.e. the claimed invention does have a single general inventive concept which is represented by the elements of claim 1 *in combination*; the applicants are not claiming each element in isolation. There has been no showing in the election of species requirement that the combination of elements does not represent a single general inventive concept (e.g. citation of prior art which teaches the applicants' combination)."

The Office Action of 28 May 2008 made the restriction final "because the applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse."

REASONS THAT HOLDING OF LACK OF UNITY OF INVENTION WAS IMPROPER

The applicants traverse the finality of the restriction because the applicants did provide a reason for the traversal and this reason was not addressed.

Moreover, attention is also directed to "According to the Report of the PCT Assembly, 18th Session (1991), item 25 (WIPO Document PCT/A/XVIII/9), the PCT Contracting States have agreed that the Patent Cooperation Treaty provisions as to unity of invention *would*

continue to apply in the national phase. This means that *designated Offices should not raise an objection to lack of unity if no such opinion is expressed in the international search report.*" (from PCT Handbook Release 6 (2000)). As no lack of unity of invention or election of species was made in the international search report, there should not now be a lack of unity of invention or election of species for the U.S. national stage application.

CONCLUSION

In view of the above, reconsideration and withdrawal of the restriction and election of species requirement is respectfully requested.

It is also believed that the application is in condition for allowance, and favorable consideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. Favorable action is earnestly solicited.

Respectfully submitted,

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